

REMARKS

In the Office Action¹, the Examiner took the following actions:

- (1) rejected claims 14, 17, 18, 33, 36, and 37 under 35 U.S.C. § 101;
and
- (2) rejected claims 1, 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36, and 37
under 35 U.S.C. § 103(a), as being allegedly unpatentable over
U.S. Patent Application Publication No. 2002/0092004 to Lee, et al.
("Lee").

By this Amendment, Applicants have amended claims 1, 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36, and 37. No claims are added, and claims 2, 10, 11, 15, 16, 19, 21, 29, 34, 35, and 38 were previously cancelled. Accordingly, claims 1, 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36, and 37 remain under examination.

I. Rejection of Claims 14, 17, 18, 33, 36, and 37 under 35 U.S.C. § 101

Claims 18 and 37

Applicants respectfully traverse the rejection of claims 18 and 37 under 35 U.S.C. § 101. In particular, the Office Action alleges that claims 18 and 37 "are directed toward instructions, but do not clearly state computer instructions." Office Action at 2. The Office Action further alleges that, "[s]ince instructions [can include] information signals[,] . . . [claims 18 and 37] do not fall within at least one of the four categories of patent eligible subject matter." *Id.*

Without acquiescing to the propriety of this characterization, Applicants have amended independent claims 18 and 37 to recite, for example, "[a] computer readable

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

storage medium storing instructions that, when executed by a processor, . . . [cause the performance of a method having], steps, performed by the processor,” to even further establish the statutory nature of claim 18 and 37 (emphasis added). As such, claims 18 and 37, as amended, recite a functional computer program stored on a physical structure, which is statutory subject matter under 35 U.S.C. § 101. See M.P.E.P. § 2106.01.I (“When a computer program is recited in conjunction with a physical structure, . . . USPTO personnel should treat the claim as a product claim.”). Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 18 and 37 under 35 U.S.C. § 101.

Claims 14, 17, 33, and 36

Applicants respectfully traverse the rejection of claims 14, 17, 33, and 36 under 35 U.S.C. § 101. In particular, the Office Action alleges that claims 14, 17, 33, and 36 “are directed towards methods that involve performance of steps [without] . . . [a] computer medium to perform the steps.” Office Action at 4. As such, the Office Action alleges that claims 14, 17, 33, and 36 are directed to non-statutory subject matter. *Id.*

Without acquiescing to this characterization, Applicants have amended claims 14 and 33 to recite, for example, “[a] computer-based method [comprising] . . . steps, performed by a computer,” to further establish the statutory nature of the claims (emphasis added). As such, Applicants respectfully submit that claims 14 and 33, as amended, are directed to statutory subject matter and request the reconsideration and withdrawal of the rejection of claims 1 and 4 under 35 U.S.C. § 101.

Claims 17 and 36 respectively depend from independent claims 14 and 33, and as such, are directed to statutory subject matter for at least those reasons set forth above for independent claims 14 and 33. Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection of these dependent claims under 35 U.S.C. § 101.

II. Rejection of Claims 1, 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36, and 37 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1, 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36, and 37 under 35 U.S.C. § 103(a), as being allegedly unpatentable over *Lee*. A *prima facie* case of obviousness has not been established with respect to any of these claims.

"The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation omitted). "[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

For example, independent claim 1, as amended, recites “[a] passer element [that] processes said set of customized meta data for input to said generating element” (emphasis added). Further, for example, independent claim 1 also recites that the processing includes “interpreting a semantical content of said set of customized meta data” and “translating said semantical content of said customized meta data into customized business process data for input into said generating element.” *Lee* fails to disclose or suggest at least these recited elements of independent claim 1.

The Office Action asserts that *Lee* discloses “[a] passer element that handles, interprets, and processes [a] set of meta data for input to [a] generating element” (emphasis added). Office Action at 5. In support of this assertion, the Office Action appears to allege that *Lee* discloses a generator program “[that] receives [a] XML document, processes the document by performing a series of validations on this document, and then creates a design database file and a system installation file” (emphasis added). Office Action at 17. However, this interpretation of *Lee* is not accurate.

In *Lee*, universal modeling language (UML) applications may be used to create XML meta documents of system designs for new software applications, and these created XML meta documents may be imported into a generator program 28 to generate validated design database files. See *Lee*, paragraph [0037] and FIG. 1. “Upon receipt of a XML meta document, the generator program 28 performs a series of validation routines on the XML meta document to ensure that the data contained therein comports with the requirements of the software development tool” (emphasis added).

Lee, paragraph [0039]. According to *Lee*, these validation routines include determining whether a data format of the received XML meta document is compatible with the software development tool. *See Lee*, paragraph [0062].

Thus, generator program 28 of *Lee* at most validates a received XML meta document by determining whether that XML meta document is formatted properly, but not by interpreting any semantic content of that XML meta document, and not by translating that interpreted semantic content into business process data. Accordingly, *Lee* fails to disclose or even suggest any processing of meta data that includes “interpreting a semantical content of [a] set of customized meta data” and “translating [the] semantical content of [the] customized meta data into customized business process data for input into [a] generating element,” as recited by claim 1.

In view of the mischaracterization of the prior art set forth above, the Office Action has neither properly determined the scope and content of the prior art, nor ascertained the differences between the claimed subject matter and the prior art. Moreover, the Office Action has pointed out nothing in the prior art that would motivate one of skill in the art to modify the teachings of the prior art to achieve the claimed combination. Accordingly, no reason has been articulated as to why one of skill in the art would find the claimed combination obvious in view of the prior art. For at least this reason, no *prima facie* case of obviousness has been established. The rejection of independent claim 1 under 35 U.S.C. § 103(a), as being obvious over *Lee*, is thus improper and should be withdrawn.

Further, independent claims 14, 18, 20, 33, 37, although differing in scope from independent claim 1, recite similar elements and are therefore allowable for at least reasons similar to those set forth above for independent claim 1. Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection of independent claims 14, 18, 20, 33, 37 under 35 U.S.C. § 103(a).

Claims 3-9, 12, 13, 17, 22-28, 30-32, and 36 depend from the independent claims. As such, these dependent claims are allowable for at least the reasons set forth above for the independent claims. Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection of these dependent claims under 35 U.S.C. § 103(a).

CONCLUSION

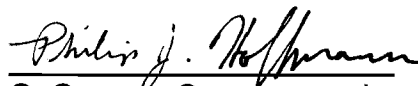
In view of the foregoing, Applicants respectfully submit that the remaining claims are in condition for allowance. Applicants, therefore, respectfully request the Examiner's reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this paper and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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Dated: May 26, 2009

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